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RJ251

  
Raymond A. Joao

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT : RAYMOND A. JOAO  
SERIAL NO.: 09/639,908  
FILED : AUGUST 16, 2000  
FOR : APPARATUS AND METHOD FOR PROVIDING FINANCIAL  
INFORMATION AND/OR INVESTMENT INFORMATION  
EXAMINER : K. CAMPEN  
GROUP : 3691

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APPLICANT'S REPLY BRIEF

Sir:

This is a Reply Brief in response to the Subsequent Examiner's Answer, mailed June 8, 2009 ("the Subsequent Examiner's Answer") in the above-identified Appeal.

Applicant respectfully submits that this Reply Brief is in

compliance with 37 C.F.R. 41.41. Entry of this Reply Brief is respectfully requested.

In the Subsequent Examiner's Answer, on pages 5-10, the Examiner presented grounds for the Examiner's rejection of Claims 42, 61-66, 68-71, 73-79, 81-89, and 91-104 under 35 U.S.C. §102 in view of Ray, et al. U.S. Patent No. 6,018,722 (Ray). On pages 10-11 of the Subsequent Examiner's Answer, the Examiner presented grounds for the Examiner's rejection of Claim 82 under 35 U.S.C. §103 in view of Ray. For the following reasons, the Examiner has failed to assert a prima facie case of unpatentability for any of the pending Claims 42, 61-66, 68-71, 73-79, 81-89, and 91-104 on appeal and, therefore, the Examiner's rejection of Claims 42, 61-66, 68-71, 73-79, 81-89, and 91-104 should be reversed.

**I. THE EXAMINER HAS FAILED TO ASSERT A PRIMA FACIE CASE OF UNPATENTABILITY FOR EACH OF THE PENDING CLAIMS ON APPEAL BECAUSE THE EXAMINER HAS FAILED TO CONSIDER ALL OF THE CLAIM LIMITATIONS OF EACH OF INDEPENDENT CLAIMS 42, 68, 73, 83, AND 94:**

Applicant respectfully submits that the Examiner has failed to assert a prima facie case of unpatentability for each of the pending Claims on appeal because the Examiner has

failed to consider all of the claim limitations of each of independent Claims 42, 68, 73, 83, and 94.

All claim limitations must be considered in judging patentability. *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970) ("All words in a claim must be considered in judging the patentability of that claim against prior art."). Applicant respectfully submits that, because the Examiner has failed to consider all of the claim limitations of each of independent Claims 42, 68, 73, 83, and 94, the Examiner has failed to assert a prima facie case of unpatentability for each and for all of the Claims on appeal, namely, Claims 42, 61-66, 68-71, 73-79, 81-89, and 91-104 and, therefore, the Examiner's rejection of each of pending Claims 42, 61-66, 68-71, 73-79, 81-89, and 91-104 should be reversed. Reversal of the Examiner's rejection of each of pending Claims 42, 61-66, 68-71, 73-79, 81-89, and 91-104 is, therefore, respectfully requested.

**IA. THE EXAMINER'S REJECTION OF CLAIMS 42, 61-66, AND 101 (GROUP A) SHOULD BE REVERSED:**

Applicant respectfully submits that the Examiner's rejection of Claims 42, 61-66, and 101 (Group A) should be

reversed because the Examiner has failed to assert a prima facie case of unpatentability regarding each of Claims 42, 61-66, and 101. Put simply, the Examiner, in the Examiner's grounds for rejection of Claim 42, at pages 5-6 of the Subsequent Examiner's Answer, and in the Examiner's grounds for rejection of Claims 61-66 and Claim 101, at page 7 of the Subsequent Examiner's Answer (Claims 61-66) and at page 9 of the Subsequent Examiner's Answer (Claim 101), respectively, has failed to consider all of the limitations of independent Claim 42, and Claims 61-66 and 101 which depend from independent Claim 42.

For example, with regard to independent Claim 42, the Examiner, at the very least, has failed to consider, and has failed to address, the limitations: "wherein the apparatus automatically initiates a communication link with the communication device, and further wherein the transmitter transmits the notification message over the communication network to the communication device, and further wherein the notification message is transmitted to the communication device in real-time", all of which limitations are specifically recited limitations of independent Claim 42.

Applicant respectfully submits that the Examiner has failed to consider, and has failed to address, the above-identified limitations of independent Claim 42 in the Subsequent Examiner's Answer. Applicant further submits that Ray, at the very least, does not disclose, teach, or suggest, the above-identified limitations of independent Claim 42.

Since all claim limitations must be considered in judging patentability, *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970), and since the Examiner has failed to consider, at the very least, the above-identified limitations of independent Claim 42, and each of Claims 61-66 and 101 which depend from independent Claim 42, Applicant respectfully submits that the Examiner has failed to assert a prima facie case of unpatentability for Claims 42, 61-66, and 101. In view of the above, Applicant respectfully submits that the Examiner's rejection of Claims 42, 61-66, and 101 is untenable and should be reversed.

In view of the foregoing, Applicant respectfully requests that the Examiner's rejection of each of Claims 42, 61-66, and 101 be reversed.

**IB. THE EXAMINER'S REJECTION OF CLAIMS 68-71 AND 102  
(GROUP B) SHOULD BE REVERSED:**

Applicant respectfully submits that the Examiner's rejection of Claims 68-71 and 102 (Group B) should be reversed because the Examiner has failed to assert a prima facie case of unpatentability regarding each of Claims 68-71 and 101. Put simply, the Examiner, in the Examiner's grounds for rejection of Claim 68, at pages 5-6 of the Subsequent Examiner's Answer, and in the Examiner's grounds for rejection of Claims 69-71 and Claim 102, at page 7 of the Subsequent Examiner's Answer (Claims 69-71) and at page 9 of the Subsequent Examiner's Answer (Claim 102), respectively, has failed to consider all of the limitations of independent Claim 68, and Claims 69-71 and 102 which depend from independent Claim 68.

For example, with regard to independent Claim 68, the Examiner, at the very least, has failed to consider, and has failed to address, the limitations: "wherein the apparatus automatically initiates a communication link with the communication device, and further wherein the transmitter transmits the notification message over the communication network to the communication device, and further wherein the

notification message is transmitted to the communication device in real-time", all of which limitations are specifically recited limitations of independent Claim 68.

Applicant respectfully submits that the Examiner has failed to consider, and has failed to address, the above-identified limitations of independent Claim 68 in the Subsequent Examiner's Answer. Applicant further submits that Ray, at the very least, does not disclose, teach, or suggest, the above-identified limitations of independent Claim 68.

Since all claim limitations must be considered in judging patentability, *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970), and since the Examiner has failed to consider, at the very least, the above-identified limitations of independent Claim 68, and each of Claims 69-71 and 102 which depend from independent Claim 68, Applicant respectfully submits that the Examiner has failed to assert a prima facie case of unpatentability for Claims 68-71 and 102. In view of the above, Applicant respectfully submits that the Examiner's rejection of Claims 68-71 and 102 is untenable and should be reversed.

In view of the foregoing, Applicant respectfully requests that the Examiner's rejection of each of Claims 68-71 and 102 be reversed.

**IC. THE EXAMINER'S REJECTION OF CLAIMS 73-79, 81, 82, AND 103 (GROUP C) SHOULD BE REVERSED:**

Applicant respectfully submits that the Examiner's rejection of Claims 73-79, 81, 82, and 103 (Group C) should be reversed because the Examiner has failed to assert a prima facie case of unpatentability regarding each of Claims 73-79, 81, 82, and 103. Put simply, the Examiner, in the Examiner's grounds for rejection of Claim 73, at pages 5-6 of the Subsequent Examiner's Answer, and in the Examiner's grounds for rejection of Claims 74-79 and 81, Claim 82, and Claim 103, at pages 7-8 of the Subsequent Examiner's Answer (Claims 74-79 and 81), at pages 10-11 of the Subsequent Examiner's Answer (Claim 82), and at page 9 of the Subsequent Examiner's Answer (Claim 103), respectively, has failed to consider all of the limitations of independent Claim 73, and Claims 74-79, 81, 82, and 103 which depend from independent Claim 73.

For example, with regard to independent Claim 73, the Examiner, at the very least, has failed to consider, and has



failed to address, the limitations: "wherein the apparatus automatically initiates a communication link with the communication device, and further wherein the transmitter transmits the notification message over the communication network to the communication device, and further wherein the notification message is transmitted to the communication device in real-time", all of which limitations are specifically recited limitations of independent Claim 73.

Applicant respectfully submits that the Examiner has failed to consider, and has failed to address, the above-identified limitations of independent Claim 73 in the Subsequent Examiner's Answer. Applicant further submits that Ray, at the very least, does not disclose, teach, or suggest, the above-identified limitations of independent Claim 73.

Since all claim limitations must be considered in judging patentability, *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970), and since the Examiner has failed to consider, at the very least, the above-identified limitations of independent Claim 73, and each of Claims 74-79, 81, 82, and 103 which depend from independent Claim 73, Applicant respectfully submits that the Examiner has failed to assert a prima facie case of unpatentability for Claims 73-79, 81, 82,

and 103. In view of the above, Applicant respectfully submits that the Examiner's rejection of Claims 73-79, 81, 82, and 103 is untenable and should be reversed.

In view of the foregoing, Applicant respectfully requests that the Examiner's rejection of each of Claims 73-79, 81, 82 and 103 be reversed.

**ID. THE EXAMINER'S REJECTION OF CLAIMS 83-89, 91-93, AND 104 (GROUP D) SHOULD BE REVERSED:**

Applicant respectfully submits that the Examiner's rejection of Claims 83-89, 91-93, and 104 (Group D) should be reversed because the Examiner has failed to assert a prima facie case of unpatentability regarding each of Claims 83-89, 91-93, and 104. Put simply, the Examiner, in the Examiner's grounds for rejection of Claim 83, at pages 5-6 of the Subsequent Examiner's Answer, and in the Examiner's grounds for rejection of Claims 84-89, Claims 91-93, and Claim 104, at page 8 of the Subsequent Examiner's Answer (Claims 84-89), at pages 8-9 of the Subsequent Examiner's Answer (Claims 91-93), and at pages 9-10 of the Subsequent Examiner's Answer (Claim 104), respectively, has failed to consider all of the

limitations of independent Claim 83, and Claims 84-89, 91-93, and 104 which depend from independent Claim 83.

For example, with regard to independent Claim 83, the Examiner, at the very least, has failed to consider, and has failed to address, the limitations: "wherein the apparatus automatically initiates a communication link with the communication device, and further wherein the transmitter transmits the notification message over the communication network to the communication device, and further wherein the notification message is transmitted to the communication device in real-time", all of which limitations are specifically recited limitations of independent Claim 83.

Applicant respectfully submits that the Examiner has failed to consider, and has failed to address, the above-identified limitations of independent Claim 83 in the Subsequent Examiner's Answer. Applicant further submits that Ray, at the very least, does not disclose, teach, or suggest, the above-identified limitations of independent Claim 83.

Since all claim limitations must be considered in judging patentability, *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970), and since the Examiner has failed to consider,

at the very least, the above-identified limitations of independent Claim 83, and Claims 84-89, 91-93, and 104 which depend from independent Claim 83, Applicant respectfully submits that the Examiner has failed to assert a prima facie case of unpatentability for Claims 83-89, 91-93, and 104. In view of the above, Applicant respectfully submits that the Examiner's rejection of Claims 83-89, 91-93, and 104 is untenable and should be reversed.

In view of the foregoing, Applicant respectfully requests that the Examiner's rejection of each of Claims 83-89, 91-93, and 104 be reversed.

**IE. THE EXAMINER'S REJECTION OF CLAIMS 94-100 (GROUP E) SHOULD BE REVERSED:**

Applicant respectfully submits that the Examiner's rejection of Claims 94-100 (Group E) should be reversed because the Examiner has failed to assert a prima facie case of unpatentability regarding each of Claims 94-100. Put simply, the Examiner, in the Examiner's grounds for rejection of Claim 94, at pages 5-7 of the Subsequent Examiner's Answer, and in the Examiner's grounds for rejection of Claims 95-100, at pages 8-9 of the Subsequent Examiner's Answer, has

failed to consider all of the limitations of independent Claim 94, and Claims 95-100 which depend from independent Claim 94.

For example, with regard to independent Claim 94, the Examiner, at the very least, has failed to consider, and has failed to address, the limitations: "and further wherein the central processing device initiates a communication link with the apparatus, and further wherein the notification message is transmitted to the apparatus in real-time", all of which limitations are specifically recited limitations of independent Claim 94.

Applicant respectfully submits that the Examiner has failed to consider, and has failed to address, the above-identified limitations of independent Claim 94 in the Subsequent Examiner's Answer. Applicant further submits that Ray, at the very least, does not disclose, teach, or suggest, the above-identified limitations of independent Claim 94.

Since all claim limitations must be considered in judging patentability, *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970), and since the Examiner has failed to consider, at the very least, the above-identified limitations of

independent Claim 94, and Claims 95-100 which depend from independent Claim 94, Applicant respectfully submits that the Examiner has failed to assert a prima facie case of unpatentability for Claims 94-100. In view of the above, Applicant respectfully submits that the Examiner's rejection of Claims 94-100 is untenable and should be reversed.

In view of the foregoing, Applicant respectfully requests that the Examiner's rejection of each of Claims 94-100 be reversed.

**II. APPLICANT'S SUMMARY OF THE CLAIMED SUBJECT MATTER IS NOT DEFICIENT:**

Applicant respectfully submits that Applicant's summary of the claimed subject matter is not deficient. On pages 3-4 of the Subsequent Examiner's Answer, the Examiner alleges that the Applicant's summary of the claimed subject matter is deficient. Applicant respectfully disagrees. Applicant respectfully submits that Applicant, at pages 3-27 of Applicant's REPLACEMENT APPEAL BRIEF, filed March 24, 2006, provided, for each independent claim on appeal, a summary of the claimed subject matter in compliance with 37 C.F.R. 41.37.

Applicant respectfully submits that the Examiner's assertions regarding the summary of the claimed subject matter should be rejected because: 1) the Examiner has failed to point out why the Examiner maintains Applicant's summary of the claimed subject matter is deficient; and 2) the Examiner's apparent attempt to describe or summarize the claimed subject matter, which appears on page 4, lines 7-15, of the Subsequent Examiner's Answer, contains limitations and extraneous language not found in any of the claims on appeal, fails to address all of the limitations of the claimed subject matter of each independent claim on appeal, and does not include any reference to the specification in support of the Examiner's summary of the claimed subject matter.

**IIA. THE EXAMINER HAS FAILED TO POINT OUT WHY APPLICANT'S SUMMARY OF THE CLAIMED SUBJECT MATTER IS DEFICIENT:**

The Examiner has failed to point out why Applicant's summary of the claimed subject matter is deficient. All the Examiner appears to state, at page 3, line 15 to page 4, line 7, of the Subsequent Examiner's Answer, are the requirements of 37 C.F.R. 41.37. The Examiner, however, provides no reason for the Examiner's assertion as to why the Examiner believes that the Applicant's summary of the claimed subject matter is deficient.

IIB. THE EXAMINER'S APPARENT DESCRIPTION OR SUMMARY OF THE CLAIMED SUBJECT MATTER CONTAINS LIMITATIONS AND EXTRANEOUS LANGUAGE WHICH IS NOT FOUND IN ANY OF THE CLAIMS ON APPEAL, DOES NOT ADDRESS THE LIMITATIONS OF THE CLAIMED SUBJECT MATTER FOR EACH INDEPENDENT CLAIM ON APPEAL, AND DOES NOT INCLUDE ANY REFERENCES TO THE SPECIFICATION:

Applicant respectfully submits that the Examiner's apparent description or summary of the claimed subject matter contains limitations and extraneous language which is not found in any of the claimed subject matter of any of the independent claims on appeal. For example, at page 4, lines 7-15, of the Subsequent Examiner's Answer, the Examiner states: "the invention is directed to a computer implemented expert securities portfolio investment management system which operates as a registered investment advisor."

Applicant respectfully submits that the Examiner's apparent description or summary is not accurate and includes limitations and extraneous language which is not contained in any of the independent claims on appeal. See, for example, independent Claim 42 ("An apparatus for providing financial information or investment information. . ."), independent Claim 68 ("An apparatus for providing financial information or investment information . . ."), independent Claim 73 ("An apparatus for providing financial information or investment information . . ."), independent Claim 83 ("An apparatus for



providing financial information or investment information . . .  
."), and independent Claim 94 ("An apparatus for providing  
financial information or investment information . . .").

For example, none of the claims on appeal contain the  
phrases or terms "expert securities portfolio investment  
management system", "registered", or "investment advisor".

Applicant further submits that the Examiner's  
assertions, at page 4, lines 7-15, of the Subsequent  
Examiner's Answer, also fails to address all of the claim  
limitations of each of independent Claims 42, 68, 73, 83, and  
94.

Applicant further submits that the Examiner's  
assertions regarding the Examiner's apparent description or  
summary of the claimed subject matter does not include any  
reference to the specification in support of same.

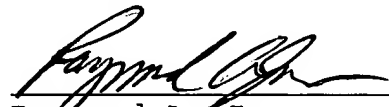
For the foregoing reasons, Applicant respectfully  
disagrees with the Examiner's assertion regarding Applicant's  
summary of the claimed subject matter. Applicant  
respectfully submits that Applicant's summary of the claimed

subject matter is in compliance with 37 C.F.R. 41.37 and is not deficient.

### III. CONCLUSION:

In view of the foregoing arguments, and in view of the arguments presented by Applicant at pages 34-139 of Applicant's REPLACEMENT APPEAL BRIEF, filed March 24, 2006, Applicant respectfully submits that the Examiner's rejection of Claims 42, 61-66, 68-71, 73-79, 81-89, and 91-104 is improper and untenable. Applicant further respectfully submits that the Examiner's rejection of Claims 42, 61-66, 68-71, 73-79, 81-89, and 91-104 should be reversed by the Board. Reversal of the Examiner's rejection of Claims 42, 61-66, 68-71, 73-79, 81-89, and 91-104, and allowance of said pending Claims 42, 61-66, 68-71, 73-79, 81-89, and 91-104 is, therefore, respectfully requested.

Respectfully Submitted,



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Encl.: - Return Receipt Postcard

July 21, 2009

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